

such teaching about bonding two substrates together anywhere in its disclosure, but discloses the following in Column 11, lines 34-44:

"The aqueous coating compositions according to the present invention may be applied to substrates using any of the various techniques known in the art. In addition, the aqueous compositions may be blended with other types of resins optionally containing isocyanate-reactive groups or with amine- or phenol-formaldehyde condensates known in the art. They can also contain pigments, leveling agents, catalysts and other auxillaries known in the art. Examples of the application techniques, resins and auxillaries are set forth in U. S. Pat. No. 4,800,008, which is herein incorporated by reference."

First, neither components of Jacobs composition can be combined with Applicants hot melt adhesive nor a blend of Jacobs composition can be combined with Applicants hot melt adhesive. Applicants hot melt adhesive is a moisture cured hot melt adhesive and would react with the water to cure the adhesive before it can be used to bond substrates together or function as a hot melt adhesive as Applicants intended. Examiner's arguments with regard to molecular weight of Jacobs pre-polymer are moot. Second, a high gloss polyurethane coating prepared from an aqueous dispersion is not equivalent to a moisture cured hot melt adhesive used to bond two or more substrates together forming a polyurethane according to the inventor and persons of average skill in the art. Third, Applicants respectfully submit Examiner has not met his burden of establishing *prima facie* case of obviousness by pointing out any teaching or suggestion within Jacobs to modify Jacobs high gloss coating to transform it to a useful adhesive for bonding two or more substrates together. Further, the burden is on the Examiner to provide the motivation for combining the two references. Applicants submits the invention as presented in amended claim 1 and 3, is patentable over Jacobs of record.

Response to 35 U.S.C. § 103(a) Rejection of Claims 2 and 3

Claims 2 and 3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs (U. S. Pat. No. 5,194,487) in view of Graham ('700) of record. Applicants respectfully traverse the rejection and submit Examiner has not met his burden of establishing *prima*

facie case of obviousness by pointing out any teaching or suggestion within Jacobs to modify Jacobs high gloss coating to transform it to a useful adhesive for bonding two or more substrates together. Applicants refer to their arguments above regarding Jacobs. Further, the burden is on the Examiner to provide the motivation for combining the two references. With all due respect, Examiner cannot pick and choose a crystalline polyester polyol of Graham and combine it with Jacobs composition. Since Jacobs compositions are incompatible with Applicants moisture cured hot melt adhesive, there is no motivation to combine references. Applicants submits the invention as presented in amended claim 2 and 3, is patentable over Jacobs in view of Graham of record.

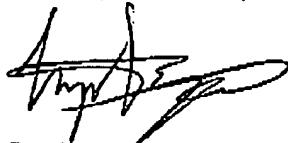
Response to 35 U.S.C. § 103(a) Rejection of Claims 4

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs (U. S. Pat. No. 5,194,487) in view of Graham ('700) of record and further in view of Haensel et al. (U. S. Pat. No. 5,162,457), and optionally further taken with Markush ('008) of record. Applicants respectfully traverse the rejection and submit Examiner has not met his burden of establishing *prima facie* case of obviousness by pointing out any teaching or suggestion within Jacobs, Graham, Haensel and optionally Markush to modify Jacobs high gloss coating to transform it to a useful adhesive for bonding two or more substrates together. Haensel *et al.* teaches a hot melt adhesive but does not teach all elements of Applicants invention in claim 4, particularly with respect to the low molecular weight limitation of the Applicants prepolymer. Applicants refer to their arguments above regarding Jacobs. Further, the burden is on the Examiner to provide the motivation for combining Haensel with any of the references. Examiner cannot pick and choose pieces of disclosure out of Haensel, pieces of disclosure out of Graham, and optionally pieces of disclosure out of Markush and combine it with Jacobs. Clearly since Jacobs compositions are incompatible with Applicants moisture cured hot melt adhesive, there is no motivation to combine references. Moreover, there is no motivation to combine a hot melt of Haensel with an aqueous polyurethane dispersion that produces a high gloss

coating in Jacobs. Applicants submits the invention as presented in amended claim 2 and 3, is patentable over Jacobs in view of Graham of record.

If the Examiner finds that there are some remaining issues to be resolved, Applicants would appreciate the Examiner to grant them a discussion or another interview with the inventor pursuant to 37 C. F. R. §1.133, to clarify any issues and to place the Application in better condition for allowance. Please charge any fees associated with this response to Deposit Account No. 18-1850.

Respectfully submitted,



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